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**AUG 5 1996**

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#16

In re Application of  
Michael W. Morgan  
Serial No. 08/390,774  
Filed: February 17, 1995  
For: METHOD AND APPARATUS FOR  
RECOGNIZING AND PERFORMING  
HANDWRITTEN CALCULATIONS

**DECISION ON PETITION**

This is a decision on the petition filed July 11, 1996, (via facsimile) under the provisions of 37 C.F.R. 1.181. Applicant requests a review of the final rejection in this application. A request for Reconsideration was mailed on Jun 11, 1996, requesting withdrawal of the final rejection made on March 14, 1996 on the grounds that the final rejection was premature.

Applicant submits that the rejections were based on prior art not previously of record (i.e. Guyon) and were directed to claims that were amended (in the responses filed on December 13, 1995 and March 1, 1996) merely to include limitations that should reasonably have been expected to be claimed. Applicant further submits that the amendments in the December 13, 1995 response merely clarified the language already in the claims and the amendments in the March 1, 1996 response merely incorporated language from dependent claims 28 and 37 into independent claims. Therefore, applicant submits that new grounds for rejection were not necessitated by the Applicant and that the final rejection should be withdrawn.

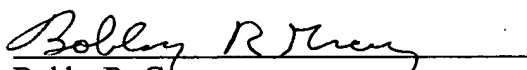
**DECISION**

Since the subject matter of applicants amendments to claims 26, 27 and 36 merely sets forth the "recognizing one or more mathematical expressions comprised of operands and operators by a relative placement of the characters" as opposed to converting the characters into one or more mathematical expressions comprised of operands and operators, there may have indeed been a need for a new ground of rejection.

However, since the amendment filed on March 4, 1996 and entered into the case on March 21, 1996 crossed in the mail with the examiner's final rejection, the issue is whether the amendment filed on December 19, 1995 and entered on January 4, 1996 had actually made necessary a new reference and/or a new rejection.

A review of the December amendment reveals that the changes were minor in nature and should not have necessitated new grounds of rejection. Since the second amendment crossed in the mail, it should have been reviewed by the examiner and a supplemental rejection would have been in order.

FINAL WITHDRAWN

  
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